



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Michael J. Briskin, Douglas J. Ringler, Dominic Picarella and Walter Newman

Application No.: 08/875,849 Group Art Unit: 1644

Filed: September 8, 1997 Examiner: R. Schwadron

Confirmation No.: 4411

For: MUCOSAL VASCULAR ADDRESSINS AND USES THEREOF

CERTIFICATE OF MAILING	
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REPLY TO OFFICE COMMUNICATION AND PETITION UNDER 37 C.F.R. § 1.8(b)

Assistant Commissioner for Patents  
P.O. Box 2327  
Arlington, VA 22202

Sir:

This paper is submitted in reply to the Office Communication dated December 2, 2002.  
In the Office Communication, the Examiner states that:

The amendment to the claims filed on **11/19/2001** does not comply with the requirements of 37 CFR 1.121(c) because of the following reasons.

*A marked up copy of claims 131, 133, 134 was not present in the instant amendment.*

Office Communication, at page 1.

Citing 37 C.F.R. § 1.121, the Examiner further states:

Since the reply filed on **1/16/2002** appears to be *bona fide*, applicant is given a TIME PERIOD of **ONE (1) MONTH** or **THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to submit an amendment in compliance with 37 CFR 1.121 in order to avoid abandonment.

Office Communication, at page 2.

A. Paper at Issue

At page 1 of the Office Communication, the Examiner refers to “[t]he amendment to the claims filed on **11/19/2001**.” At page 2 of the Office Communication, the Examiner refers to “the reply filed on **1/16/2002**.” Applicant’s records reveal that, concurrently with the subject Continued Prosecution Application, a Preliminary Amendment with a Certificate of Facsimile Transmission and Marked-Up Version of Amendments (pp. i - iv) was filed under 37 C.F.R. § 1.8 on November 19, 2001. Applicant’s records show no paper filed in this case on January 16, 2002. An inspection of PAIR records also fails to identify a paper filed in this case on January 16, 2002. Accordingly, it is believed that the reference at page 2 to “the reply filed on **1/16/2002**” was made in error and the paper at issue is the Preliminary Amendment filed on November 19, 2001.

B. Transmittal of Copy of Preliminary Amendment with Certificate of Facsimile Transmission and Marked-Up Version of Amendments (pp. i - iv)

In reply to the Office Communication, a complete copy of the Preliminary Amendment with Certificate of Facsimile Transmission (pp. 1-26) and Marked-Up Version of Amendments (pp. i - iv) (30 pages total), which was transmitted to the Patent Office via facsimile on November 19, 2001, is filed herewith. Page -iv- of the Marked-Up Version of Amendments illustrates the amendments made to Claims 131, 133 and 134. It is believed that the enclosed copy complies with 37 C.F.R. § 1.121.

## C. Petition Under 37 C.F.R. § 1.8(b)

The Examiner states that a marked up copy of Claims 131, 133 and 134, illustrating the amendments made, is not present in the Preliminary Amendment. However, copies of the papers in Applicant's Attorney's files show that on November 19, 2001, the following documents were transmitted to the Patent Office via facsimile:

- (1) Facsimile Cover Sheet (1 page);
- (2) Continued Prosecution Application (CPA) Request Transmittal with Receipt for same (3 pages total);
- (3) Petition for Extension of Time with Certificate of Facsimile Transmission (1 page);
- (4) Notice of Withdrawal of General Authorization to Charge Fees with Certificate of Facsimile Transmission (1 page);
- (5) Request for Corrected Filing Receipt with Certificate of Facsimile Transmission, copy of Filing Receipt (with changes noted in red) and copy of pages 1-2 of Preliminary Amendment (5 pages total);
- (6) ***Preliminary Amendment with Certificate of Facsimile Transmission (pp. 1-26) and Marked-Up Version of Amendments (pp. i - iv) (30 pages total);***
- (7) Copy of Transmittal of Executed Declaration Under 37 C.F.R. § 1.132 (pages 1-2) and Executed Declaration (pages 2-8) from parent (9 pages total); and
- (8) Copy of Unexecuted Declaration from parent (8 pages).

As can be seen from the list above, a total of 58 sheets, including the Preliminary Amendment (pp. 1-26) with Marked-Up Version of Amendments (pp. i - iv) (30 pages total), were transmitted to the Patent Office on November 19, 2001. A copy of the Preliminary Amendment with Marked-Up Version of Amendments (pp. i - iv), which was transmitted in accordance with 37 C.F.R. § 1.8 by Ms. Sandra Jammal of this office, is enclosed. As can be seen from the enclosed copy, the Preliminary Amendment bears a Certificate of Facsimile Transmission executed by Ms. Sandra Jammal on November 19, 2001, certifying that "this correspondence is being facsimile transmitted to the United States Patent and Trademark Office: on 11-19-01." A copy of the sending unit's report confirming transmission of 58 sheets on November 19, 2001 is also enclosed. Because the complete Preliminary Amendment with Marked-Up Version of Amendments (pp. i - iv) was transmitted in accordance with 37 C.F.R. § 1.8 on November 19,

2001. Applicant hereby requests that the complete submission be considered timely under 37 C.F.R. § 1.8(b).

D. Additional Comments

37 C.F.R. § 1.704 provides for a reduction in the period of adjustment of Patent Term under certain circumstances deemed to constitute a failure of the applicant to engage in reasonable efforts to conclude prosecution. Under 37 C.F.R. § 1.704(c)(7), "[s]ubmission of a reply having an omission (§ 1.135(c))" is considered to be a circumstance that constitutes a failure to engage in reasonable efforts to conclude prosecution. The Preliminary Amendment filed on November 19, 2001 addressed the issues raised in the Office Action made final mailed on May 17, 2001. As established herein, the Preliminary Amendment with Marked-up Version of Amendments (pp. i - iv) in compliance with 37 C.F.R. § 1.121 was transmitted to the Patent Office on November 19, 2001 and was received by the Patent Office. Accordingly, the Preliminary Amendment contained no omission under 37 C.F.R. § 1.135(c) and no reduction in adjustment of Patent Term should be incurred.

Authorization is hereby granted to charge Deposit Account No. 08-0380 for any fees required under 37 C.F.R. 1.16 and 1.17 in order to maintain pendency of this application. Please charge any additional fee that may be due in this matter to Deposit Account No. 08-0380. A copy of this authorization is enclosed for accounting purposes.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

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Dated:

*January 2, 2003*